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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/082,468 | 02/25/2002 | Shawn Domenic Loveland | 13768.254 | 4394 |

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| 47973 | 7590 | 12/20/2005 |

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| EXAMINER |
|---|
| AVELLINO, JOSEPH E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2143 | |

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/082,468 | LOVELAND ET AL. |
| | Examiner | Art Unit | |
| | Joseph E. Avellino | 2143 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>21 October 2005</u>.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-31 and 35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 June 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some *  c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1. Claims 1-31 and 35 are pending in this application.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7, 11-18, 21-29, 31 and 35, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Anderson et al. (U.S. 2002/0194307 A1) hereinafter 'Anderson' in

view of Oppenheimer et al (US 2003/0014477 A1) hereinafter "Oppenheimer".

Regarding claims 1, 11-12, 21-23, 30-31 and 35, Anderson taught, sending from

the client over the wireless network a document inclusion instruction to the server, not

including the document, but including an identification of the document that does not

depend on the server prior knowledge about the document, therefore the server would

retrieve the document based on the client identification of the document (see section

0040 of the specifications [e.g. fetching or querying the store or a database with a list of

the content of the store]) and not based on the server prior knowledge of existing

attachable files (Anderson: fig.1 [mobile device 153] and paragraphs 0025, 0030-0036);

**and** (as per claims 1, 11, 23 and 30) if the identified document is already stored at the

server, the client's document-inclusion being sufficient to permit the server to carry out

the instruction and the client therefore taking no further action (Anderson: paragraphs

0036-0038 and 0039 [explaining client's action that do not depend on whether the

document is identifiable or not]).


Anderson did not expressly taught details regarding the course of action to be

performed after the server indicates to the client that the file was not found (Anderson:

paragraph 0077).


Oppenheimer taught sending an identifier of a file to be used to determine if

another copy of the file is already stored on the server 204, then if the file already exist

in the server no further action ("need not be uploaded") is required by the user

(Oppenheimer: paragraph 0045), but if the identified document is not already store at

the server, then receiving from the server an indication that the document identified in

the document-inclusion instruction is unavailable so the client may determine whether to

send the identified document of not (Oppenheimer: paragraph 0046); **or** (as per claims

21 and 35) ensuring that a document-inclusion operation corresponding to the

document-inclusion instruction is performed by the client if and only if the client is

advised by the server that the identified document is not already stored at the server so

as to conserver the network bandwidth of the wireless network (Oppenheimer:

paragraph 0046).

It would have been obvious to one of ordinary skill in the art working with

Anderson at the time the invention was made to modify the teachings of Anderson with

the teachings of Oppenheimer, since both motivated the exploration of the art of

retrieving a document on behalf of a user and indicating the user that the file is not

found within the server (Oppenheimer: 0045-0046 and Anderson: 0036-0037 and 0040).

The combination would have improved Anderson teachings by providing the document

retrieval operation even when the file is available to the client (Oppenheimer: 0045) and

further providing a clear course of action to provide the document to the server when

the server is not able to find the document (Oppenheimer: 0046). Although

Oppenheimer does not explicitly state that the client determines whether to send the

document to the server, rather merely states that the file is downloaded from the client

(p. 6, ¶ 46) one of ordinary skill in the art would find this feature obvious in order to

conserve bandwidth on the users network, thereby allowing more control over what the

computer does and how it utilizes the bandwidth (i.e. defer upload until a later time,

when allowed by the user, etc.).

Anderson modified by the teachings of Oppenheimer is hereinafter referenced to

as the combination.

Regarding claims 2, 3, 13, 14, 24 and 25, the combination further taught sending

the document-inclusion instruction in a new electronic mail message and forwarding an

electronic mail message (Anderson: 0040 ["then the user may specify a destination

address for the document 189 in the request email message transmitted to the

document retriever 186"]).

Regarding claims 4, 5, 15, 16, 26 and 27, the combination further taught that the

calendar capabilities were included in the range of capabilities offered by PDA's and

other portable devices (Anderson: 0002). The examiner additionally notes that other

portable devices include personal portable computers (laptops) with extended

processing capabilities. It is further noticed that such portable devices such as laptop

computers were commonly equipped with electronic mail clients such as MS Outlook®

(MUA or Mail User Agent) to interface with electronic mail servers such as MS

Exchange (MTA or Mail Transfer Agent). It is further noticed that MS Outlook® and MS

Exchange provided document attachment capabilities in meeting requests at the time

the instant invention was made. Since extending the attachment capabilities to other

services provided by an email client was already well known in the art, extending

document inclusion capabilities related to the elimination of attachments to such other

services would be a matter of choice.

Regarding claims 6, 7, 17, 18, 28 and 29, the combination further taught printing in a

particular printer using the document-inclusion instruction (Anderson: 0040 ["*The reply*

*email message is then transmitted to the corresponding automated print agent 166*

*designated to receive the emails addressed to the printer alias 186 wherever it resides*

*in the local area network 109 to print the document 189 on the printer 136 as was*

*described previously"]).*

**3.** Claims 8, 9, 10, 19, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Anderson et al. (U.S. 2002/0194307 A1) hereinafter 'Anderson' in view of

Oppenheimer et al (US 2003/0014477 A1) hereinafter "Oppenheimer"; and further in

view of LaRue et al. (U.S. 6,535,892 B1) hereinafter 'LaRue'.

Regarding claims 8, 9, 10, 19, 20 the combination taught the invention substantially

as claimed, however the combination did not expressly teach details regarding a client

and a server performing a version update process upon identifying that the requested

version is unavailable. Nevertheless, the combination motivated the exploration of the

art of using a digest or file identification information to determine if an identical <u>version</u>

of the file is already stored within server 204 as appropriate (Oppenheimer: 0045).

LaRue taught a client that determines version conflicts between client and server

versions of the same document, the client sending version indicator and the changes in

comparison with the found version in order to synchronize a dataset (column 12 line 48

to column 13 line 37).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the teachings of the combination with the teachings of LaRue *in*

*order to resolve version conflicts* (column 12 line 48 to column 13 line 37). Note that

sending the whole document in a synchronization process is a normal procedure when document is not found at all, since there is no document to synchronize with. One of ordinary skill in the art working with the combination would be motivated to explore the art of electronic messaging and the use of portable devices to access a messaging system (Anderson: [0002 and 0008]); which is also part of LaRue disclosure (column 1 lines 59-64, column 2 lines 32-46 and column 3 lines 1-31). One of ordinary skill in the art would also be motivated the exploration of the art of using a digest or file identification information to determine if an identical <u>version</u> of the file is already stored within server 204 as appropriate (Oppenheimer: 0045). Therefore, combining the combination with the teachings of LaRue (column 12 line 48 to column 13 line 37) would provide a resolution mechanism to act in response to a negative notification, responsive to a document-inclusion instruction (Anderson: 0076-0077). *The combination would have resulted improved by adding an efficient method to further overcome problems entailed by a document not found error or an outdated version.*

### Response to Arguments

1.    Applicant's arguments dated October 21, 2005 have been fully considered but are not persuasive.

In the remarks, Applicant argues, in substance, that (1) Oppenheimer does not specifically disclose that the client determines whether to send the document to the

server, (2) Oppenheimer has nothing to do with document-inclusion instructions at all,

and (3) Anderson teaches away from sending document-inclusion instructions to a

server where it is unknown whether the document exists.

2.    As to point (1) the Office requests Applicant to view the rejection of claim 1

above. This provides sufficient motivation as to why it would be obvious for

Oppenheimer to have the client to send the document.

3.    As to point (2) the Office respectfully disagrees. Applicant's disclosure, page 3,

states that a document inclusion operation "typically requires the transmission of an

electronic message with a corresponding document attachment" (lines 1-3). IN order for

a user of Oppenheimer's system to make a file on a local file system available to other

users on server 204, it inherently requires the file to be uploaded to the system, as well

as an instruction from the client to the server to share the file (i.e. permissions, location,

etc.). This clearly shows that Oppenheimer is dealing with document inclusion

operations and as such the rejection is maintained.

4.    As to point (3) the Office respectfully disagrees. Anderson merely does not deal

with files which are not located on the server. This actually provides motivation in order

to find the server to find the correct file for the user. As such this clearly does not teach

away from sending document-inclusion instructions to a server where it is unknown

where the document is, in order to facilitate the user to find the file.

### Conclusion

5.     The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
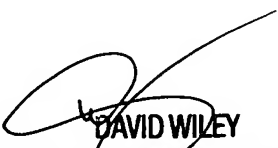
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905.  The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
December 5, 2005

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100